

1. Claims 1 to 7, 11 and 15 to 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added amounts of release modifier and solvent are not supported by the specification.

While the Examiner understands applicants' calculations for arriving at the newly added amount of release modifier, this amount taken in totality with the rest of the claim is not supported by the specification. Specifically, as originally filed and found in the specification, there can only be .5 to 30 wt% of the modifier per weight of (a). This limitation is no longer present in the claims. Thus, there can be as much as 6 wt% of modifier for as little as 2 wt% (a). This corresponds to 300 wt% modifier per weight of (a). On the other hand, there can be as little of .01 wt% modifier and 20 wt% (a). This is significantly less than the originally disclosed lower limit of .5 wt% per (a). As can be seen from this, applicants have actually broadened the amount of (b) from that originally disclosed and this is considered to be new matter.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Reference to "said assisting substrates" lacks antecedent basis.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 7, 11 and 15 to 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hockemeyer et al.

Hockemeyer et al. teach an adhesive repellent coating. Column 2, lines 55 to 6, teaches a silicon compound that corresponds to the claimed compound (a). Column 5, lines 40 and on, teach the addition of another siloxane which corresponds to the release modifier (b). Particular attention is drawn to Example 4 in which a siloxane having vinyl and hydrogen groups is admixed with a siloxane having only vinyl groups. This corresponds to applicants' (a) and (b). The mixture is diluted to include 95 wt% solvent. This differs from that claimed only in that the amounts of (a) to (b) (as they correspond to the claimed components) are 1.66 wt% and 3.34 wt%. This is a difference of .34 in the amount of (a). A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. In the instant application, one would expect that compositions within the prior art range and the claimed range would have the same properties since both function as release agents. In this manner claim 1 is rendered obvious by Hockemeyer et al.

For claim 2, please see column 5, line 40 and on, which teaches the amount of the siloxane additive but does not teach an amount. Adjusting the amount of this compound in the composition of Example 4 would have been well within the skill of the ordinary artisan. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation).

For claims 4 to 7, note that the siloxane in Example 4 has this structure while column 5 teaches a viscosity range that overlaps with that claimed.

For claim 11, note that a platinum catalyst is used in Hockemeyer et al.

For claim 16, note that the preferred Si-H/Si-vinyl lower ratio is 5:1 which is close to the ratio of 4.8 such that one having ordinary skill in the art would have found this difference to have been obvious. For claims 16 and 17, also note that column 3, lines 35 and on, teach that correlation between Si-H/Vi-vinyl ratio and adhesive repellency such that one having ordinary skill in the art would have been motivated to adjust the ratio in an effort to optimize and/or adjust the adhesive repellency of the prior art composition.

Art Unit: 1796

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi et al.

This anticipation rejection is not directed to the specifically elected species, but to the generic claim. Hayashi et al. teach a release film that comprises different silicone compounds. See for instance Example 1 in which 100 parts by weight of a siloxane copolymer gum (which corresponds to the generic silicone (a)) and 5 parts by weight of a dimethylsiloxane-hexenylmethylsiloxane-hydrogenmethylsiloxane copolymer (which corresponds to the generic silicone release modifier (b) in claim 3) and a platinum catalyst are added to 700 parts by weight toluene. This meets each claimed component in the claimed amounts.

7. Claims 1 to 7, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al.

In addition to being anticipated, as noted supra, Hayashi et al. render obvious the instant claims. In this regard note column 4, lines 42 and on, which teaches the addition of a non-reactive polysiloxane. This component could be considered a silicone release modifier as well. Note that 1 part per 100 parts by weight of (A) can be added to the composition. If 1 part of this siloxane were added to the composition in Example 1, this would correspond to 1 part of the release modifier per 5 parts of the Si-H and Si-vinyl containing siloxane (which is a type of silicone compound (a)). This composition would also meet the requirements of claim 1. Thus, given this interpretation of the prior art, one having ordinary skill in the art would have found the claimed composition obvious.

For claim 2, note that adjusting the amount of solvent and each component in the prior art composition would have been well within the skill of the ordinary artisan. For

instance, in Example 1, if one were to have doubled the amount of solvent, in an effort to produce a coating composition having a lower viscosity or to prepare a final coating of decreased solids content, the resulting composition would meet the limitations found in claim 2. As such one having ordinary skill in the art would have found this claim limitation to have been well within routine experimentation and/or optimization.

For claims 4 to 7, the Examiner notes that both (A) and (B) in Hayashi et al. fall within the breadth of formula (I). In addition, component (E) on column 4 falls within the breadth of formula (I). Thus one having ordinary skill in the art would have found such a component obvious. For instance, since the siloxane (I) can have a polydimethylsiloxane backbone, the preferred siloxane (E) meets the structural formula of (I). Since patentees teach using a liquid siloxane, one having ordinary skill in the art would have found the selection of a molecular weight within the claimed range to have been obvious. The Examiner notes that the claimed molecular weight range corresponds to a viscosity range of about 50 to 1000 cSt.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

Margaret G. Moore
Primary Examiner
Art Unit 1796

mgm
6/9/08